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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/588,514	11/17/2006	Shoya Yoda	293946US40PCT	2046
22850 7590 06/25/2010 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER PEZZUTO, HELEN LEE				
ART UNIT 1796		PAPER NUMBER		
NOTIFICATION DATE 06/25/2010		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/588,514

Applicant(s)

YODA ET AL.

Examiner

Helen L. Pezzuto

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4, 6, 8-14 and 20-22 is/are pending in the application.
- 4a) Of the above claim(s) 11-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 6, 8-10 and 20-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1, 4, 6, 8-14, 20-22 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ ~~Notice of Informal Patent Application~~
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/11/10 has been entered.

Response to Amendment

Applicant's amendment to claim 1, the cancellation of claim 7 filed in the response on 6/11/10 is acknowledged. Currently, claims 1, 4, 6, 8-10, and 20-22 are under consideration in this application. Responsive to applicant's amendment, JP-03-227489 is withdrawn as applied reference because it discloses 0.01-20 mol% of combined amount of monomer (A) and (B), which is outside of the recited range.

Election/Restrictions

2. Claims 11-14 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions, there being no allowable generic or linking claim.

Election was made **without** traverse in the reply filed on 9/30/09.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1, 4, 6-10, and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 19532229 for the reasons of record.

DE-229 discloses a water-soluble polymer dispersion comprising 50-99.99 wt% of at least one water-soluble monomer (a1), 0.01-10 wt% N-methylol group-containing crosslinking monomer (a2), up to 1 wt% of polyethylenically unsaturated crosslinking monomer (a3), up to 30 wt% of a hydrophobic monomer (a4), and up to 20 wt% of an amphiphilic monomer (a5) (see abstract; page 3, lines 5-16). Suitable water-soluble monomer (a1) include N-(2-hydroxyethyl) (meth)acrylamide (page 4, line 52), 3-(N,N,N-trimethylammoniummethyl) (meth)acrylate chloride,

3-(N,N,N-trimethylammonium)propyl (meth)acrylate chloride, and 3-trimethylammoniumpropyl (meth)acrylamide chloride (page 5, lines 14-15, 18), disclosed within the scope of the instant monomer (A) and (B) as expressed in the present claims. The resultant polymer is taught to have a weight average molecular weight of at least 5×10^5 Dalton, meeting the range expressed in claim 8 (page 13, lines 28-29). Accordingly, it would have been obvious to one having ordinary skill in the art to prepare a water-soluble polymer comprising a mixture of (a1) monomers as taught, motivated by the reasonable expectation of success.

Response to Arguments

Applicant's amendment and remarks filed on 6/11/10 have been fully considered. Applicant repeated the same argument that DE-229 lists a broad spectrum of monomers which may be used as monomers, but does provides suggestion for selecting the combinations of the vinyl monomers (A) and (B) as recited. The examiner remains of the position that DE-229 clearly teaches selecting at least one water soluble monomers (a1) encompassing the recited monomer species (A) and (B) as expressed in claims 1, 4, and 6 (page 4, line 52; page 5, lines 14-15, 18). Thus, one having ordinary skill in the art would have been motivated to select at least one of the suitable monomers as suggested, motivated by the reasonable expectation of success as taught. It

is well settled that it is prima facie obvious for a skilled artisan to indiscriminately choose some from the list disclosed by the prior art, if the reference teaches that any one will work. Furthermore, applicant's comparative data set forth in Tables 3 and 4 have been fully considered. The examiner is of the position that applicant's comparative data is not commensurate in scope with the degree of protection sought by in the recited claims. Only selective and limited ranges of (A) and (B) have been compared, whereas the claims are much broader with respect to what they can be and their relative ranges. Moreover, the features/properties upon which applicant relies are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. Accordingly, the examiner's position is maintained.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen L. Pezzuto whose telephone number is (571) 272-1108. The examiner can normally be reached on 8 AM to 4 PM, Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization

where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Helen L. Pezzuto/
Primary Examiner
Art Unit 1796

hlp